

1619  
#13  
PATENT

Customer Number 22,882  
Attorney Docket No. 05725.0622-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Arnaud VILBERT

Application No.: 09/582,714

PCT Appl'n No.: PCT/FR99/02585

PCT Filed: October 25, 1999

National Stage Entry: June 20, 2000

For: AEROSOL DEVICE  
CONTAINING A  
CONDENSATION POLYMER  
COMPRISING AT LEAST A  
POLYURETHANE AND/OR  
POLYUREA UNIT

)  
)  
) Group Art Unit: 1619

)  
) Examiner: L. Wells

RECEIVED

OCT 26 2001

TECH CENTER 1600/2900

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

**RESPONSE TO ELECTION OF SPECIES REQUIREMENT**

In the September 24, 2001, Office Action, the Examiner indicated that while Applicant previously elected a species of the film forming polymer, a species within the claim limitations was not elected for the block chosen from polyurethane and polyurea blocks. The Examiner further requested that Applicant define all variables of any formula to be elected.

LAW OFFICES

FINNEGAN, HENDERSON,  
FARABOW, GARRETT,  
& DUNNER, L.L.P.  
1300 I STREET, N. W.  
WASHINGTON, DC 20005  
202-406-4000

Applicants elect, with traverse, the following species: For the polycondensate (A), Applicants elect formula (I'), set forth in claim 39, wherein X' is O; and R is C<sub>1</sub> to C<sub>20</sub> cycloaliphatic radicals. Applicants do not believe it is necessary to elect any specific species for B of claim 39, as it is defined simply as a substituted or unsubstituted hydrocarbon-based radical. As the film forming polymer (B), Applicants elect grafted silicone polymers comprising a polysiloxane portion and a non-silicone organic chain portion, as set forth in claim 58. These species correspond to the example on page 37 of the specification, and are read on by claims 27-35, 39-41, and 43-48, 58, and 60-71. Claim 46 reads on the elected film forming polymer (B) when R<sub>7</sub> and R<sub>8</sub> are hydrogen, R<sub>9</sub> is a lower alkyl group and n is 0.

Applicants traverse the election requirement on the grounds that the Examiner has failed to properly show that claims 27-71 lack unity of invention, as required by PCT Rules 13.1 and 13.2. Unity of invention has to be considered in the first place *only in relation to the independent claims* and not the dependant claims. See M.P.E.P. § 1850 (A). If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. *Id.* In particular, there is unity of invention in the case of a genus/species situation where the genus claim avoids the prior art. *Id.* Only if an independent genus claim does not avoid the prior art may an objection based on lack of unity between a genus and a species be raised, and then only if no inventive link remains between the genus and the species. *Id.* In order to make such a determination, the Examiner must first assess the prior art and then determine if a link exists between the genus and the species. *Id.*

LAW OFFICES

FINNEGAN, HENDERSON,  
FARABOW, GARRETT,  
& DUNNER, L.L.P.  
1300 I STREET, N. W.  
WASHINGTON, DC 20005  
202-408-4000

In the present case, the Examiner has not shown that any of the independent genus claims do not avoid the prior art. Without such as showing, the Examiner cannot show that an inventive link does not exist between the genus and species, and therefore cannot show that there is lack of unity of invention.

Furthermore, the Examiner's arguments in support of the election of species requirement are based entirely on limitations from the dependant claims. As pointed out above, unity of invention has to be considered in the first place only in relation to the independent claims and not the dependent claims.

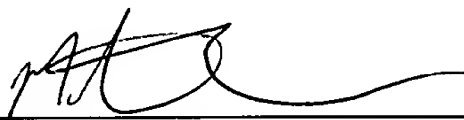
For these reasons, Applicants respectfully request that the election of species requirement be withdrawn. Moreover, if the Examiner does maintain the election of species requirement, Applicants request that the Examiner broaden the search to include the non-elected species, once the elected species is found to be allowable.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: October 24, 2001

By:   
Matthew L. Whipple  
Reg. No. 47,217

LAW OFFICES

FINNEGAN, HENDERSON,  
FARABOW, GARRETT,  
& DUNNER, L.L.P.  
1300 I STREET, N. W.  
WASHINGTON, DC 20005  
202-408-4000